



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/474,138	12/29/1999	ERIK L. SMITH	2685/5393	1912

23838 7590 09/05/2002

KENYON & KENYON
1500 K STREET, N.W., SUITE 700
WASHINGTON, DC 20005

EXAMINER

NGUYEN, QUYNH H

ART UNIT	PAPER NUMBER
----------	--------------

2642

DATE MAILED: 09/05/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/474,138

Applicant(s)

SMITH, ERIK L.

Examiner

Quynh H Nguyen

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 1998.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 7, 8, 10-16, 18, 19, 21, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Harlow et al. (U.S. Patent 5,206,901).

Regarding claim 1, Harlow et al. disclose a method for forwarding an incoming call addressed to one of a plurality of Directory Numbers belonging to a subscriber, including: receiving an incoming call to a fixed-site device at one of a plurality of numbers belonging to the subscriber (col. 4, lines 35-41); determining that a busy/no-answer condition exists for the fixed-site device (col. 4, lines 58-59); consult a call forward setting for the subscriber (col. 4, lines 52-54); and performing a call forwarding action to a mobility device based upon the call forward setting of the subscriber (col. 5, lines 43-48).

Regarding claims 2, 10, and 11, Harlow et al. disclose the fixed site device is a fixed-site telephone belonging to the subscriber, and the incoming call or performing a call forwarding is received at a Class 5 Switch associated with the subscriber's fixed-site telephone (col. 5, lines 61-67).

Regarding claims 3 and 4, Harlow et al. disclose the Class 5 Switch attempts to deliver the incoming call to the subscriber's fixed-site device, determines that a busy/no-answer

condition exists at the device, consults the subscriber's call forward setting, wherein the call forward setting is stored in the Class 5 Switch, and based upon the subscriber's call forward setting, forwards the call to a mobility device belonging to the subscriber or sending the call to a Mobile Switching Center associated with the Directory Number of the subscriber's mobility to the subscriber (col. 5, lines 22-48).

Regarding claims 7 and 12, Harlow et al. disclose detecting a busy/no-answer condition at the mobility device, and routing the call to voice mail (col. 48-54).

Claim 8 is rejected for the same reasons as claim 1. Incoming call to a fixed-site device then forwarded to a mobility device or vice versa are treated the same (col. 5, lines 39-60).

Claims 13 and 18 are rejected for the same reasons as claim 1. Harlow et al. teach a medium/memory coupled to processor for storing instructions (Fig. 1, 170).

Regarding claim 14, Harlow et al. disclose the instructions are adapted to be executed by a processor in a Class 5 Switch (Fig. 1, 110, 120, and 130).

Claim 15 is rejected for the same reasons as claim 13. Harlow et al. disclose a medium storing instructions adapted to be executed by a processor (Fig. 1, 130).

Regarding claim 16, Harlow et al. disclose the instructions are adapted to be executed by a processor in a Mobile Switching Center (Fig. 1, 133).

Claim 19 is rejected for the same reasons as claim 15 and 18.

Regarding claims 21 and 22, are rejected for the same reasons as claim 19. Harlow et al. disclose formulate a routing instruction based upon subscriber profile, and the routing instruction to an external switch (col. 5, lines 62-67 and Fig. 1, 110, 120, and 130).

Claim Rejections - 35 USC § 103

Art Unit: 2642

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5, 6, 9, 17, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harlow et al. (U.S. Patent 5,206,901).

Regarding claims 5, 6, 9, 17, and 20, Harlow et al. disclose the steps of: receiving/sending a request for routing information from the Mobile Switching Center (Fig. 1, 130); sending/receiving routing information based upon the subscriber profile (col. 5, lines 49-60). However, Harlow et al. do not disclose Home Location Register. The Home Location Register is inherent in mobile communication *or at least extremely obvious.*

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Eisdorfer et al. (U.S. Patent 5,706,339) teach Technique for use in processing personal telephone calls. Skysjy (U.S. Patent 5,487,111) teaches telecommunications system sequence calling.

6. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-6306, (for formal communications intended for entry, please

label the response "EXPEDITED PROCEDURE")

Art Unit: 2642

or: (703) 308-6296, (for informal or draft communication, please label
"PROPOSED" or "DRAFT")


Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal
Drive, Arlington, VA, Sixth Floor (Receptionist).

7. Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Quynh H. Nguyen whose telephone number is 703-305-5451.
The examiner can normally be reached on Monday - Thursday from 6:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Ahmad Matar, can be reached on (703) 305-4731. The fax phone number for the
organization where this application or proceeding is assigned is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding
should be directed to the receptionist whose telephone number is 703-305-4700.

qhn
Quynh H. Nguyen
August 20, 2002


AHMAD MATAR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600